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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/680,012 10/07/2003 Michael Furst FURST, M-1 4718

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EXAMINER

SIMONE, CATHERINE A

ART UNIT PAPER NUMBER

1794

MAIL DATE DELIVERY MODE

10/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/680,012

Applicant(s)

FURST, MICHAEL

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 August 2007.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2, 7, 9, 11, 14, 16-21, 24 and 28-32 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 2, 7, 9, 11, 14, 16-21, 24 and 28-32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 - Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 - Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Withdrawn Rejections

1. The 35 U.S.C. 103(a) rejection of claims 2, 7, 9, 11, 14, 16, 18, 20, 21, 24, 28-30 and 32 over Rowe in view of Hurst and in view of Wiercinski et al. and in view of patent DE 20019212U of record in the previous Office Action mailed 3/8/2007, Pages 3-7, Paragraph #7 has been withdrawn due to the Applicant's amendment filed 8/9/2007.
2. The 35 U.S.C. 103(a) rejection of claims 17 and 19 over Rowe in view of Hurst and in view of Wiercinski et al. and in view of patent DE 20019212U and further in view of Zickell of record in the previous Office Action mailed 3/8/2007, Pages 7-8, Paragraph #8 has been withdrawn due to the Applicant's amendment filed 8/9/2007.
3. The 35 U.S.C. 103(a) rejection of claim 31 over Rowe in view of Hurst and in view of Wiercinski et al. and in view of patent DE 20019212U and further in view of Kalkanoglu of record in the previous Office Action mailed 3/8/2007, Page 8, Paragraph #9 has been withdrawn due to the Applicant's amendment filed 8/9/2007.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 2, 7, 9, 11, 14, 16-21, 24 and 28-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 8, 17-20 and 22-24 of copending Application No. 10/680,013. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims of the copending application is broader than that of the instant claims, rendering them obvious over each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 2, 7, 9, 11, 14, 16, 18, 20, 21, 24, 28-30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al. (US 5,687,517) in view of Hurst (US 3,900,102).

Regarding claims 14 and 32, Wiercinski et al. teach a film-bitumen combination consisting of at least three layers wherein the at least three layers consist of a bituminous layer (Figs. 1 and 2, #12) and at least two film layers made from different materials (Fig. 2, #22 and #22A and see col. 1, lines 57-60), the bituminous layer being coated on the at least two film layers (col. 2, lines 38-49), the at least two film layers consisting of a first film layer and a second film layer produced from a polyolefin, polypropylene, polyamide, or polyethylene terephthalate (PET) (col. 2, lines 45-49 and col. 4, lines 31-36), the first film layer being located further away from the bituminous layer and inherently having a larger coefficient of elongation than the second film layer (col. 4, lines 16-30), since the layers are each made up of materials similar to those materials of the film layers disclosed in Applicant's present Specification. Additionally, Wiercinski et al. disclose a surface of a side of the combination facing away from the bituminous layer having been treated to have non-slip properties (col. 4, lines 1-16 and col. 6, lines 46-50), and each individual film layer is arranged in the combination in accordance with its thermal stability and its mechanical strength (col. 4, lines 11-30 and col. 5, lines 14-17). Wiercinski et al. also teach a barrier layer (col. 6, lines 58-64).

Wiercinski et al. fails to disclose a first edge of the at least two film layers projecting beyond the bituminous layer and a second edge of the at least two film layers being shorter than the bituminous layer, and the barrier layer consisting of a layer of lacquer.

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Hurst teaches that it well known in the art to have a first edge of a film layer (Fig. 1, #2 at 10) project beyond a bituminous layer (Fig. 1, #4) and the second edge of the film layer be shorter (Fig. 1, #2 at 8) than the bituminous layer (Fig. 1, #4; also see col. 8, line 67 to col. 9, line 3) for the purpose of forming a continuous membrane which does not contain and is not susceptible to the formation of channels for the flow or collection of water and is highly resistant to damage during installation and failure thereafter when joined with other bituminous/film strips and laminated to a substrate.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the edges of the two film layers in Wiercinski et al. to have the first edge of the film layers project beyond the bituminous layer and the second edge of the film layers be shorter than the bituminous layer as suggested by Hurst in order to form a continuous membrane which does not contain and is not susceptible to the formation of channels for the flow or collection of water and is highly resistant to damage during installation and failure thereafter when joined with other bituminous/film strips and laminated to a substrate. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the barrier layer in Wiercinski et al. to consist of a lacquer, since it has been held that a change in the material would be an unpatentable modification in absence of showing unexpected results and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. See MPEP 2144.07.

Regarding claim 2, the at least two film layers in Wiercinski inherently have different coefficients of thermal expansion (col. 3, lines 49-53), since the layers are each made up of

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materials similar to those materials of the film layers disclosed in Applicant's present Specification. Regarding claim 7, in Wiercinski the PET layer is oriented (col. 4, lines 36 and 62-63). Regarding claim 9, in Wiercinski the at least two film layers are laminated to a bituminous layer individually or together (col. 2, lines 38-57). Regarding claim 11, note in Wiercinski at least one film layer facing the bituminous layer provides a mineral oil barrier (col. 4, lines 25-30). Regarding claim 16, note in Wiercinski the non-slip treatment is carried out by means of coating (col. 6, lines 46-50). Regarding claim 18, note in Wiercinski the non-slip treatment is carried out by means of at least partial embossing of the surface (col. 3, lines 62-65). Regarding claim 24, note in Wiercinski a tie layer or an adhesive disposed between two adjacent layers of the at least two film layers (col. 5, lines 18-19). Regarding claim 28, note in Wiercinski a release liner provided on the surface of the bituminous layer facing away from the at least two film layers (Fig. 3, #40 and col. 3, lines 1-5). Regarding claims 29 and 30, note the release liner in Wiercinski is siliconized paper (col. 3, lines 1-2).

Regarding claims 20 and 21, Wiercinski et al. teach a non-slip coating (col. 6, lines 46-53). However, Wiercinski et al. fail to specifically teach the non-slip coating consisting of a thermoplastic elastomer with a metallocene complex and of a syndiotactic polystyrene. It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the non-slip coating in Wiercinski et al. to consist of a thermoplastic elastomer with a metallocene complex and of a syndiotactic polystyrene, since it has been held that a change in the material would be an unpatentable modification in absence of showing unexpected results and it has been held to be within the general skill of a worker in the art to

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select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

8. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al. (US 5,687,517) in view of Hurst (US 3,900,102) and further in view of Zickell et al. (US 4,992,315).

Wiercinski et al. and Hurst teach the film-bitumen combination as shown above. However, Wiercinski et al. fails to disclose the non-slip coating and the embossing being shorter at least along one edge of the combination. Zickell et al. teaches that it is well-known in the art to have an embossed non-slip film (Fig. 3, #28) being shorter along at least one edge of a film-bitumen combination for the purpose of providing a small portion having slip resistance where one can stand to reduce the risk of falling (col. 4, lines 63-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the non-slip coating and embossing in Wiercinski et al. to be shorter at least along one edge of the combination as suggested by Zickell et al. in order to provide only a portion that is slip resistant where one can stand to reduce the risk of falling.

9. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al. (US 5,687,517) in view of Hurst (US 3,900,102) and further in view of Kalkanoglu (US 4,757,652).

Wiercinski et al. and Hurst teach the film-bitumen combination as shown above. However, Wiercinski et al. fail to disclose the release liner having several sections. Kalkanoglu teaches that it is well-known in the analogous art to have a release liner with several sections for the purpose of allowing the material to be flopped back, so that one side can be stuck, and then

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the other side can be flopped down and stuck (see col. 1, lines 5-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the release liner in Wiercinski et al. to have several sections as suggested by Kalkanoglu in order to allow the material to be flopped back, so that one side can be stuck, and then the other side can be flopped down and stuck.

Response to Arguments

10. Applicant's arguments with respect to claims 2, 7, 9, 11, 14, 16-21, 24 and 28-32 have been considered but are moot in view of the new grounds of rejection, which are presented above.

Conclusion


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571) 272-1501. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Catherine A. Simone/
Catherine A. Simone
October 17, 2007


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SUPERVISORY PATENT EXAMINER
AU 1794